REMARKS

Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, 30, 31, 35, 37, 39, 47 and 61-63 are pending in the instant application. Claims 30, 31, 35, 37, 39, 47 and 61-63 have been withdrawn from consideration by the Examiner. Claims 1-3, 6, 8, 10, 16, 19, 20, 22 and 23 have been rejected. New claims 72-81 have been added. Support for this amendment is provided in the specification at page 39 lines 2-3, page 40 lines 24-25, page 51 lines 20-24, and in claims 3, 6, 8, 10, 22 and 23. No new matter is added by this amendment. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement

The Examiner has made final the Restriction Requirement mailed July 19, 2007. Applicants reserve the right to request rejoinder of withdrawn process claims 30, 31, 35, 37, 39, 47 and 61-63 upon allowance of product claim 1 from which the claims ultimately depend from.

II. Objection to Specification

The Examiner suggests that page 24 of the instant specification contains several trademarks which are not correctly denoted. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have

amended the specification by capitalizing each trademark and providing the generic terminology for each trademark.

Withdrawal of this objection is respectfully requested.

III. Rejection of Claims 6, 19 and 23 and Objection to Specification under 35 U.S.C. 112, first paragraph

Claims 6, 19 and 23 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The specification has also been objected to under 35 U.S.C. 112, first paragraph as failing to provide an adequate written description of the invention and failing to provide an enabling disclosure without complete evidence that the claimed biological materials are known and readily available to the public or complete evidence of the deposit of the biological materials. Specifically, the Examiner suggests that it is unclear if a cell line which produces an antibody having the exact chemical identity of the Pro104 antibody produced by hybridomas Pro104.C25.1, Pro104.D9.1 and Pro104.K81.15 is known and publicly available, or can be reproducibly isolated without undue experimentation.

Applicants respectfully disagree.

At the outset, it is respectfully pointed out that Table 10 at page 149 of the instant specification has been

amended to clarify the deposit dates for hybridomas Pro104.C25.1, Pro104.D9.1 and Pro104.K81.15 to be June 15, 2004.

Further, Applicants respectfully direct the Examiner to Example 14 beginning at page 148 of the instant specification wherein the deposit information for these three hybridomas as well as the required assurances are set forth. Contrary to the Examiner's suggestion, it is made clear in Table 10 that the hybridomas were deposited prior to the effective filing of the PCT application to which the instant application corresponds. Further, Applicants state therein that:

> Hybridoma cell lines were deposited with the American Type Culture Collection (ATCC) located at 10801 University Boulevard, Manassas, Virginia 20110-2209, U.S.A., and accorded accession numbers.
>
> and
>
> The organisms will be made available by ATCC under the terms of the Budapest Treaty, and subject to an agreement between diaDexus, Inc. and ATCC, which assures permanent and unrestricted availability of the progeny of the cultures to the public upon issuance of the pertinent U.S. patent or upon laying open to the public of any U.S. or foreign patent application, whichever comes first, and assures availability of the progeny to one determined by the U.S. Commissioner of Patents and Trademarks to be entitled thereto according to 35 USC §122 and the Commissioner's rules pursuant thereto (including 3 7 CFR §1.14 with particular reference to 886 OG 638).

Accordingly, the specification makes clear that these hybridomas were deposited prior to the effective filing date of the instant application, provides the address at which the deposit was made and provides assurances of availability to the public, thus clearly meeting the requirements of 35 U.S.C. 112, first paragraph.

Withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 1, 3 and 16 under 35 U.S.C. 102(b)

Claims 1, 3 and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by Antalis et al. (U.S. Patent 6,479,274).

Applicants respectfully traverse this rejection.

Applicants disagree with the Examiner's suggestion that Antalis et al. teach an antibody that binds to Pro104 on a mammalian cell in vivo as claimed. Column 15, last paragraph of Antalis et al. (cited by the Examiner) outlines the potential utility of testisin as a therapeutic target and column 18 paragraph 4 (also cited by the Examiner) teaches characteristics of anti-testisin antibodies. Neither of these sections teach an antibody that has the characteristic of binding to Pro104 on a mammalian cell in vivo. In fact, the term "in vivo" does not appear in Antalis et al.

Therefore, despite Antalis et al. contemplating testisin as a therapeutic target, and antibodies in general, Antalis et al. does not teach an antibody that binds to Pro104 on a mammalian cell in vivo. Accordingly, since this reference does not teach all the elements of the instant claimed invention, it cannot anticipate the instant claimed invention. See MPEP 2131.

Withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 1, 3, 16 and 20 under 35 U.S.C. 102(b)

Claims 1, 3, 16 and 20 have been rejected under 35 U.S.C. 102(b) as being anticipated by Bandman et al. (U.S. Patent 6,203,979).

Applicants respectfully traverse this rejection.

Applicants disagree with the Examiner's suggestion that Bandman et al. teach an antibody that binds to Pro104 on a mammalian cell in vivo. Column 28 of Bandman et al. (cited by the Examiner) teaches general characteristics of antibodies to HUPM and column 26 line 59 through column 27 line 7 (also cited by the Examiner) teaches administration HUPM polypeptides, not antibodies to HUPM, to a subject. Neither of these sections teach an antibody that has the characteristic of binding to Pro104 on a mammalian cell in vivo.

Therefore, despite Bandman et al. contemplating antibodies to HUPM in general, Bandman et al. does not teach an antibody that binds to Pro104 on a mammalian cell in vivo. Accordingly, since this reference does not teach all the elements of the instant claimed invention, it cannot anticipate the instant claimed invention. See MPEP 2131.

Withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 1-3, 8, 10, 16, 20 and 22 under 35 U.S.C. 103(a)

Claims 1-3, 8, 10, 16, 20 and 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bandman et al. (U.S. Patent 6,203,979) in view of Queen et al. (U.S. Patent 6,180,370).

Applicants respectfully traverse this rejection.

As discussed in Section V above, Bandman et al. does not teach an antibody that binds to Pro104 on a mammalian cell in vivo. Queen et al., which is unrelated to antibodies to Pro104, does not remedy the deficiencies of Bandman et al. t

Therefore, the combined references, which do not teach or suggest all the limitation of the claimed invention, cannot render the claimed invention obvious. See MPEP 2143.

Withdrawal of this rejection is therefore respectfully requested.

VII. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

Kathleen A. Tyrrell
Reg. No. 38,350

Date: **January 10, 2008**

LICATA & TYRRELL P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515